REMARKS/ARGUMENTS

In view of the foregoing amendments and the following remarks, the applicants respectfully submit that the pending claims comply with 35 U.S.C. § 112, comply with 35 U.S.C. § 101, and are not rendered obvious under 35 U.S.C. § 103. Accordingly, it is believed that this application is in condition for allowance. **If, however, the Examiner believes that there are any unresolved issues, or believes that some or all of the claims are not in condition for allowance, <u>the applicants respectfully request that the Examiner contact the undersigned to schedule a telephone Examiner Interview before any further actions on the merits</u>.**

The applicants will now address each of the issues raised in the outstanding Office Action. Before doing so, however, both the undersigned and John C. Pokotylo would like to thank Examiners Sanders and Pannala for courtesies extended during a telephone interview on March 12, 2008 (referred to as "the telephone interview"). The telephone interview is summarized here.

Telephone Interview Summary

This statement of the substance of the Interview summarizes the issues discussed during the March 12, 2008 telephone. interview. This Interview Summary is presented in the format suggested in MPEP § 713.04 by the Patent Office.

Date of Interview: March 12, 2008
Type of Interview: Telephone

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Name of Participants:

       -      Examiners: Aaron J. Sanders

                                 Sathyanarayan R. Pannala

       -      For Applicants: John C. Pokotylo

                                 Len Linardakis

A.   *Exhibit(s) Shown:*   None

B.   *Claims discussed:*   1-3 and 36

C.   *References Discussed:*

       -    U.S. Patent Publication No. 2003/0131095

           ("the Kumhyr publication")

       -    U.S. Patent Publication No. 2002/0010757 ("the Granik publication")

D.   *Proposed Amendments Discussed:*

     - The Examiners suggested amending the claims to replace use of the term "signaling" with the term "indicating" as used in the specification to overcome the written description requirement based rejection.

     - The Examiners suggested amending claim 36 to include additional structure to overcome the § 101 rejection.

     - The Examiners indicated that combining the elements of claims 2 and 3 into claim 1 would be useful in overcoming the § 103 rejection with respect to the Kumhyr and Granik publications.

E.   *Discussion of General Thrust*
       of the Principal Arguments

     - The applicants' representatives described an exemplary embodiment consistent with the claimed

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invention and the teachings of the Kumhyr and Granik publications.

- The applicants' representatives discussed the fact that the "condition" being determined and used in the claimed invention was the same condition, while the conditions analyzed in the Kumhyr and Granik publications, and therefore in the combination proposed by the Examiner, are different conditions.

- The applicants' representatives requested clarification of how the Examiner was combining the references and demonstrated that the proposed combination did not teach the method of claim 1.

- The applicants' representatives requested clarification of what the Examiner considered to be the first and second entities in the cited references as recited in claim 1.

F.   *Other Pertinent Matters Discussed:* None

G.   *General Results/Outcome of Interview*

- The Examiners agreed that amending the claims to replace use of the term "signaling" with the term "indicating" as used in the specification would overcome the written description requirement. The applicants' representatives agreed to amend the claims as proposed (subject to the approval of the applicants).

- The Examiners agreed that amending claim 36 to include additional structure such as, for example, a processor and a storage device storing instructions which are executed by the processor, would overcome the § 101 rejection. The applicants' representatives

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agreed to amend the claim as proposed (subject to the approval of the applicants).

- The Examiners indicated that combining the elements of claims 2 and 3 into claim 1 would be useful in overcoming the § 103 rejection with respect to the Kumhyr and Granik publications.

Objections

The title was found to not be descriptive. The title has been amended to be more clearly indicative of the claimed invention. Therefore, the applicants request that the Examiner reconsider and withdraw this objection.

Rejections under 35 U.S.C. § 112

Claims 1, 20 and 36 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

In rejecting claims 1, 20 and 36, the Examiner contends that the act of "signaling" is not disclosed in the specification or the claims as originally filed. (See Paper No. 20071205, page 2.) Although the subject matter of the claim need not be described literally (using the same terms), and although the applicants submit that the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date, the applicants had possession of the claimed invention, in order to expedite prosecution, claims 1, 20 and 36 have been amended to replace the term "signaling" with the term

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"indicating". Support for this amendment is provided in Paragraph [0050] of the present application. During the telephone interview, the Examiners agreed that such an amendment would overcome the outstanding written description rejection.

In view of the foregoing amendments and remarks, the applicants respectfully submit that claims 1, 20 and 36 meet the written description requirements of 35 U.S.C. § 112, first paragraph. Consequently, this ground of rejection should be withdrawn.

Rejections under 35 U.S.C. § 101

Claims 1-38 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory matter. The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Claims 1-35

In rejecting claims 1-35, the Examiner contends that the disclosed subject matter does not produce a tangible result. Specifically, the Examiner states:

> the disclosed subject matter provides an indication that _may_ enable a publisher to render alternative content, see [0054]. Since the 'indication' _may_ enable the publisher, it also may not, so it is not clear that this is a tangible result. [Emphasis in original.]

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(Paper No. 20071205, page 3) The applicants respectfully disagree.

First, independent claim 1, as amended, does not recite that a second or alternative entity (e.g., the publisher) may or may not render alternative content. Claim 1, as amended, positively recites acts which produce the tangible result of either (a) *providing a set of at least one ad* to be rendered if a condition is met, or (b) if the condition is not met, *indicating the availability of at least a portion of the resource to a second entity*. It does matter whether or not the publisher actually renders alternative content once it receives the notification. Furthermore, the Examiners acknowledged during the telephone interview that claim 1, as amended, would be directed towards statutory subject matter.

Similarly, independent claim 29 does not recite that a second or alternative entity (e.g., the publisher) may or may not render alternative content. Claim 29 positively recites acts which produce the tangible results of (a) *receiving a request* to provide content to be rendered, and either (b) *determining whether to provide at least one ad* responsive to the request or (c) if it determines not to provide at least one ad, *redirecting the request to an alternative entity*. It does matter whether or not the publisher actually renders alternative content once it receives the redirected request. Thus, claim 29 provides a concrete and tangible result.

In view of the foregoing remarks, the applicants respectfully submit that claims 1 and 29 meet the requirements of 35 U.S.C. § 101 and are directed towards statutory subject matter. Since claims 2-28 and 30-35 directly or indirectly depend from claims 1 and 29,

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respectively, these claims similarly are directed towards statutory subject matter. Accordingly, the applicants respectfully request that the Examiner withdraw this ground of rejection with respect to claims 1-35.

Claims 36-38

In rejecting claims 36-38, the Examiner states that the system recited does not require any hardware, making it software *per se*, and as such, these claims are non-statutory. (See Paper No. 20071205, page 3.) The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Claim 36 has been amended in a manner that was agreed to during the telephone interview by the Examiners such that the amended claim would overcome the outstanding § 101 rejection.

In view of the foregoing amendments, the applicants respectfully submit that claims 36-38 recite statutory subject matter under 35 U.S.C. § 101. Since claims 37 and 38 depend from claim 36, these claims similarly are directed towards statutory subject matter. Therefore, the applicants respectfully request that this ground of rejection be withdrawn.

Rejections under 35 U.S.C. § 103

Claims 1-22 and 25-38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0131095 ("the Kumhyr publication") in

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view of U.S. Patent Application Publication No.
2002/0010757 ("the Granik publication").

First, one skilled in the art would not have been
motivated to combine the Kumhyr and Granik publications as
proposed by the Examiner. The Kumhyr system concerns:

> a mechanism which provides some control
> *by the sponsor of advertising* to be
> delivered in association with web page
> content to mitigate against the
> association of the sponsors advertising
> with *content* that may create a negative
> association with the advertiser's
> product or service. [Emphasis added.]

(Paragraph [0005] of the Kumhyr publication) Clients 102
may request Web pages from server 106 which includes the
"mechanisms for avoiding inappropriate display of
advertisements in Web pages." (See paragraph [0017] of the
Kumhyr publication.) When a client 102 requests a Web
page, prior to serving the Web page, the server 106 will
monitor the datastream as the Web page is generated and
either determine (a) whether or not to display the ad or
(b) contact the advertiser to inquire whether the ad should
be displayed. (See Figure 4 and Figure 6 of the Kumhyr
publication.)

By contrast, the Granik publication concerns an ad
replacement system which:

> functions to parse downloaded web-page
> code *containing undesired advertisement
> content* and filter out the undesired
> advertising content by preventing it
> from being displayed, and then replaces
> the filtered out web-based advertising
> with personalized and more appropriate
> content, i.e. other advertisements or

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information. As will be described in
greater detail herein, the advertising
content or information that is **_replaced_
by the client application may be based
on user profile information....**
Furthermore, the act of replacing an ad
for user viewing, referred to herein as
an "impression", entitles the user to
certain rewards based on their
subscription. [Emphasis added.]

(Paragraph [0018] of the Granik publication) As can be
appreciated from the foregoing, **the client device** in the
Granik system analyzes Web page code **which has been served**
for "undesirable ads". A filter mechanism then filters out
the "undesirable ads" and replaces them with new
advertisements based on their relevance to the users'
profile information for presentment to the user and, that
enables users to earn money based on user actions.

Neither the Granik publication, nor the Kumhyr
publication, contains any teaching, suggestion, or obvious
reason to combine these references as proposed by the
Examiner to produce the claimed invention. That is, one
skilled in the art would not have combined a system which
gives web servers or advertisers the ability to block ads
from being served in association with **inappropriate web
content**, with a system which **allows client web browsers** to
replace **undesirable ads** which **have already been served** to
the client web browser with new advertisements based on
user profile information for presentment to the user (and
that enables users to earn money based on user actions), in
order to produce a method of (1) determining whether or not
a condition is met, responsive to an ad request associated
with a target document, wherein the target document is
associated with a resource for rendering content, (2) if it

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is determined that the condition is met, a first entity providing a set of at least one ad to be rendered via the resource, and (3) if it is determined that the condition is not met, the first entity indicating the availability of at least a portion of the resource to a second entity. Consequently, claims 1-22 and 25-38 are not rendered obvious by the cited references for at least this first reason.

Next, regardless of the absence or presence of motivation to combine, claims 1-22 and 25-38 are not rendered obvious by the cited references since these claims recite features not included in the combination of the Kumhyr and Granik publications proposed by the Examiner.

Independent claim 1, as amended, is not rendered obvious by the cited references because neither the Kumhyr publication, nor the Granik publication, either taken alone or in combination, teaches or suggests acts of (1) determining whether or not a condition is met, responsive to an ad request associated with a target document, wherein the target document is associated with a resource for rendering content, (2) if it is determined that the condition is met, a first entity providing a set of at least one ad to be rendered via the resource, and (3) if it is determined that the condition is not met, the first entity indicating the availability of at least a portion of the resource to a second entity. In rejecting claim 1, the Examiner contends that the Kumhyr publication teaches the first two aforementioned features. The Examiner concedes that the Kumhyr publication does not teach signaling the availability of at least a portion of the resource to a second entity. However, the Examiner contends that paragraph [0018] of the Granik publication teaches that:

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> '[t]he application... filter[s] out the
> undesired advertising content by
> preventing it from being displayed, and
> then replaces the filtered out web-based
> advertising with personalized and more
> appropriate content, i.e. other
> advertisements,' where the claimed
> 'condition' is that the referenced
> advertisement contains 'undesirable
> content' and the claimed 'signaling' is
> the referenced 'replac[ing].'

(See Paper No. 20071205, page 5.) The applicants respectfully disagree.

In embodiments consistent with the claimed invention, it is determined whether or not a condition is met, and if the condition is met, a first entity will, for example, provide a set of ads to be rendered in an available ad spot within a target document. If that **same condition** is not met, the first entity indicates the availability of the resource (e.g., an ad spot) to a second entity.

By contrast, the Kumhyr and Granik publications analyze **different conditions**. Specifically, the Kumhyr system determines whether or not requested web content includes inappropriate material which would cause an advertiser to avoid associating their product/service with the inappropriate web content. Meanwhile, the condition in the Granik publication is whether an advertisement is considered "undesirable" because it is not considered as relevant or as valuable to a user.

During the telephone interview, Examiner Sanders agreed that the conditions are different. However, the Examiner stated that he is using the Kumhyr publication to teach whether or not the condition is met, and is only using the Granik publication to teach "signaling the

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availability of at least a portion of the resource to a second entity." However, under this interpretation, if the Kumhyr system determines that the condition is <u>not</u> met (e.g., the Web content includes inappropriate content and insertion of the ad is not approved), then the ad will not be served at all. (See blocks 418-426 in Figure 4 of the Kumhyr publication.) Thus, if the condition is not met in the Kumhyr system, the ad spot will not be filled and, therefore, there will be no ad in that ad spot for the Granik system to filter and replace.

Furthermore, the combination of the cited references as proposed by the Examiner does not teach a **first entity**, indicating the availability of at least a portion of the resource to a **second entity**. During the telephone interview, Examiner Sanders initially stated that the first and second entities could be interpreted as the first entity being the client device and the second entity being the ad replacer server cluster 25 in the Granik publication. During the telephone interview, the applicants explained that such an interpretation would not meet all the claim elements.

Specifically, this characterization does not teach the features since the client device (the first entity as characterized by the Examiner) does not indicate the availability of a resource (e.g., an ad spot) to a second entity (the second entity as characterized by the Examiner). This is because the client device merely replaces undesirable ads with ads **which have been previously downloaded and stored** locally. (See paragraph [0035] of the Granik publication.) Therefore, there would be no need for the client device to indicate the availability of the resource to the ad replacer server

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cluster 25. That is, the entity which filters out the undesirable ads is the same entity which replaces those undesirable ads with ads locally stored.

The Examiner seemed to appreciate this difference, but then argued that the first and second entities could read on two different computer applications which may be included on the client device in the Granik publication. However, this still does not teach the features as arranged in claim 1 because a computer program on the client device (the first entity as characterized by the Examiner) does not provide a set of at least one ad to be rendered via the resource if the condition is met, and therefore, cannot be considered to be the same first entity which indicates the availability of a resource to a second computer program on the client device (the second entity as characterized by the Examiner).

As can be appreciated from the foregoing, independent claim 1 is not rendered obvious by the Kumhyr and Granik publications for at least these reasons. Independent claims 29 and 36 are similarly not rendered obvious by the cited references. Since claims 1-22 and 25-28 directly or indirectly depend from claim 1, since claims 30-35 directly or indirectly depend from claim 29, and since claims 37 and 38 depend from claim 36, these claims are similarly not rendered obvious by the cited references.

Dependent claims 2-4 are further distinguished from the cited references since claim 2 recites that the first entity includes a content ad system, claim 3 (which depends from claim 2) recites that the second entity includes a publisher with which the target document is associated, and claim 4 (which depends from claim 3) recites that the act

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of determining whether the condition is met is performed by the first entity (i.e., the content ad system).

During the telephone interview the Examiners indicated that combining the elements of claims 2 and 3 into claim 1 would be useful in overcoming the § 103 rejection with respect to the Kumhyr and Granik publications. However, the applicants have not combined claims 2 and 3 into claim 1 at this time since claim 1 is patentable over the cited references for the reasons discussed above. Thus, dependent claims 2-4 are not rendered obvious by the Kumhyr and Granik publications for at least these additional reasons.

Dependent claim 5 is further distinguished from the cited references since it recites that "the condition" depends on whether the first entity determines the target document can be crawled or not. That is, the first entity determines whether the content of the target document can be analyzed for negative content for example. The portion of the Kumhyr publication cited by the Examiner as teaching this feature concerns a user Web browser which allows the user to search the World Wide Web for a Web page and subsequently retrieve and display the Web pages on the user's computer screen. (See Paper No. 20071205, page 6.) This does not teach determining whether a target document can be crawled as would be understood by one skilled in the art. Thus, dependent claim 5 is not rendered obvious by the Kumhyr and Granik publications for at least this additional reason.

Dependent claim 9 is further distinguished from the cited references since it recites that "the condition"

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depends on whether the first entity determines if a
threshold number of **sufficiently relevant ads are available
to render** in association with the target document. The
portion of the Kumhyr publication cited by the Examiner as
teaching this feature merely concerns whether **the number of
negative key items within a target document exceeds a
threshold amount**. (See Paper No. 20071205, page 7.) This
does not teach determining if there is a threshold number
of **sufficiently relevant ads are available to render** in
association with the target document as would be understood
by one skilled in the art. Thus, dependent claim 9 is not
rendered obvious by the Kumhyr and Granik publications for
at least this additional reason.

Dependent claim 20 is further distinguished from the
cited references since claim 20, as amended, recites that
the act of indicating the availability of the resource
includes **the first entity <u>setting a location field in an
outgoing hypertext protocol header with the identifier,</u>
causing the target document to be output to the client
system with the content rendered by the second entity**. The
portion of the Granik publication cited by the Examiner as
teaching claim 20 merely concerns a background application
which is a utility that filters and replaces content based
on personal profile, target URL and keywords. (See Paper
No. 20071205, page 7.) This does not teach a first entity
indicating the availability of at least a portion of the
resource to a second entity, wherein the act of indicating
the availability to a second entity includes **<u>setting a
location field in an outgoing hypertext protocol header
with the identifier</u>**. Thus, dependent claim 20 is not

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rendered obvious by the Kumhyr and Granik publications for at least this additional reason.

Claims 23 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Kumhyr publication in view of U.S. Patent No. 6,959,424 ("the Gardner patent").

Since claims 23 and 24 indirectly depend from claim 1, the applicants believe that the Examiner intended to reject these claims under a combination of the Kumhyr and Granik publications and the Gardner patent. In any event, the purported teaching of the Gardner patent would not compensate for the deficiencies of the Kumhyr and Granik publications with respect to claim 1, discussed above, regardless of the scope of purported teaching of the Gardner patent, and regardless of the absence or presence of an obvious reason to combine these references. Consequently, claims 23 and 24 are not rendered obvious by the cited references for at least this reason.

New Claims

New dependent claims 39 and 40 depend from claims 29 and 36, respectively. These claims are supported by claims 2, 3 and 17.

Amendments to the Specification

The title has been amended to be more clearly indicative of the claimed invention.

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Entry of Amendments

Since the amendments are directed to overcoming
rejections under 35 U.S.C. §§ 101 and 112 rejections set
forth in a previous Office action, which rejections were
discussed and resolved during the telephone interview, they
raise no new issues and present the claims in better form
for consideration on appeal. Accordingly, these amendments
should be entered. Since new dependent claims 39 and 40
include subject matter already found, for example, in
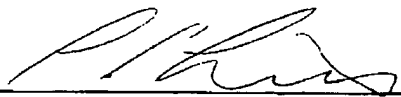claims 2, 3 and 17, they raise no new issues and should be
entered.

Conclusion

In view of the foregoing amendments and remarks, the
applicants respectfully submit that the pending claims are
in condition for allowance. Accordingly, the applicants
request that the Examiner pass this application to issue.

Any arguments made in this amendment pertain *only* to
the specific aspects of the invention *claimed*. Any claim
amendments or cancellations, and any arguments, are made
without prejudice to, or disclaimer of, the applicants'
right to seek patent protection of any unclaimed (e.g.,
narrower, broader, different) subject matter, such as by
way of a continuation or divisional patent application for
example.

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Respectfully submitted,
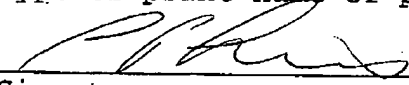
March 20, 2008

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_____   March 20, 2008
Signature   Date

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